

REMARKS

Applicant's undersigned attorney would like to thank Examiners Sutton and Welch for the courtesies extended him during the May 25, 2006 interview. During the interview, it was pointed out that the patentable significance lies in both the nature of the information placed on the headwear piece and its strategic location.

Claims 1-3 and 5-21 are currently pending in the application.

Claims 16 and 18 stand objected to under 37 C.F.R. 1.75(c) as being in improper dependent form for allegedly failing to limit the subject matter of a previous claim. The Office Action asserts that the subject matter of claim 16 has been previously recited in claim 1, lines 15-17, and claims 6 and 7. However, Applicant respectfully submits that this objection is based upon a misunderstanding of claim 1. Specifically, claim 1 recites "second information identifying a plurality of participants in the event on at least one of [the six recited octants]." (Emphasis added). Therefore, claim 1 only requires the second information on at least one of the octants. Claims 6 and 7 recite what specific form the second information of claim 1 takes, such as a logo associated with a team. However, claim 16 further limits the structure such that the logos appear "on each of [the six recited octants]." (Emphasis added). The structure recited in claim 16 differs from that recited in claim 1 in that claim 16 requires that the second information (logo) appears on each of the six recited octants, whereas claim 1 requires only that the second information appear on at least one of the octants. Therefore, this objection should be withdrawn.

Claim 18 stands objected to because the Examiner alleges it is unclear how the claim further limits the device. Claim 18 further limits the device as to which of the eight octants the second information appears. Claim 1, from which claim 18 depends, permits

the second information to appear on the front/right side octant and the front/left side octant, as well as any of the remaining eight octants. Claim 18 specifically limits the structure such that the second information does not appear on either of those two specific octants. Therefore, claim 18 does further limit the device and the objection should be withdrawn.

Claim 13 stands rejected under 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 13 recites “wherein a plurality of logos in the at least one octant have a normal orientation and are skewed from the normal orientation.” The Office Action asserts that it is unclear how the logos can have a normal orientation and be skewed from the normal orientation. This claim is reciting that the logos have a normal orientation, but are being claimed as skewed from the normal orientation. This structure is best seen in Figures 7-8. Specifically, Figure 7 depicts the logos in the normal orientation while Figure 8 depicts the logos skewed from the normal orientation, as recited in claim 13. Therefore, Applicant asserts that claim 13 is not indefinite and that the objection be withdrawn.

Claims 2-3, 5-9, and 11-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,175,963 (Loeffelholz) in view of U.S. Patent No. 6,370,696 (Kronenberger). As an initial matter, claim 1 was not specifically rejected in the Office Action. Clarification is requested.

This rejection is improper and should be withdrawn as the Office Action has not given full meaning to the recited language in the claims. Specifically, independent claim 1, from which all remaining claims depend, recites “first information identifying an event on at least one of the front/left side and front/right side octants; and second information

identifying a plurality of participants in the event on at least one of [six recited octants].” This structure is simply not disclosed or suggested in the cited references.

The Examiner correctly acknowledges that Loeffelholz does not disclose a front right or left side identifying an event or showing a plurality of participants. To overcome this deficiency, the Examiner attempts to combine Loeffelholz with Kronenberger. The Examiner alleges that Kronenberger discloses designs that include schools, objects, information, etc. around the cap. However, this alleged disclosure is not what is recited in claim 1 which requires first and second information each having specifically claimed locations on the cap. Therefore, the cited references, taken alone or in combination, fail to disclose the recited first information and second information and the locations specified in claim 1.

To overcome this further deficiency, the Examiner states on page 4 of the Office Action, “it is the opinion of the examiner that the information claimed, provides no structure to the cap that is not shown in the prior art are mere design choices”, which indicates that the Office Action has not given patentable weight to the specific information or locations recited. The Office Action continues, relying on *In re Seid*, 161 F.2d 229, 73 U.S.P.Q. 431 (C.C.P.A. 1947) to indicate that matters relating to ornamentation only cannot be relied upon to patentably distinguish the claimed invention from the prior art. Applicant agrees that ornamentation alone cannot be used in a utility patent to distinguish the prior art. However, *In re Seid* is distinguishable from the present case. *In re Seid* concerns a bottle arranged to give the impression of the human body. The applicant in that case attempted to distinguish over prior art based upon the ornamental appearance of the bottle. Conversely, Applicant in the present case is relying upon the function of the first and

second information, as well as the specific locations of the respective information to educate an observer of the cap as to the contents of the information as opposed to simply providing ornamentation. The resultant ornamental appearance of the information is simply a secondary result of the appearance of the information on the cap.

For example, the first information might include the event such as a playoff game or an all star game. The second information might relate to participants in that event. By reason of its location, the first information, pertaining to the event, is viewable from the front of the headwear piece, whereas the second information is not clearly viewable from the same perspective. Those viewing the headwear piece from the front thereof will be apprised of the identification of the event. As the viewing perspective changes, the information relating to the participants can be clearly focused upon. From the front, the information is strategically located so as to highlight the event, while at the same time, the headwear bears information pertaining to the participants. This information as well as the recited locations must be given patentable weight.

The location is especially significant in the present invention as it turns the headwear piece into a multi-functional structure. For example, the headwear piece can be worn by a player, such as for pictures used during the game when the player is at bat, and the information located on the at least one of the front/left side and front/right side octants is seen in the picture highlighting such information as the event or player's team affiliation. Therefore, the headwear piece serves the function of a traditional headwear piece worn before, during and after a game by a player. The second information identifies a plurality of participants in the event which may not be required to be seen in the pictures used during the game when the player is at bat. Therefore, the second information may or may

not be visible when the headwear piece is viewed from the front. However, souvenir collectors and fans alike often desire souvenirs which contain all of the participants from the game as well as souvenirs that are identical to the headwear pieces worn by the players. The recited headwear piece performs both of these functions as the piece is a souvenir as well as the same hat worn by the players. Therefore, the location of the information on the claimed multi-functional headwear piece must be given patentable weight.

Applicant notes that the contents of the “information” must not be ignored and must be considered in determining patentability. The Federal Circuit *In re Gulack* 217 USPQ 401 (Fed. Cir. 1983) stated that “[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter” (at page 403).

The Court stated further that “[u]nder Section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole” (at page 403).

Furthermore, the present case is similar to *In re Miller*, 418 F.2d 1392, 153 U.S.P.Q. 46 (C.C.P.A. 1969) and *In re Gulack* as opposed to *In re Seid*.

In re Miller concerned a measuring device having information printed on the device to educate an observer as to quantities when making fractional recipes without having to actually compute the fractional quantity necessary. The Patent Office initially rejected the claims as it did not see a structural relationship between the information and the device. The Federal Circuit reversed the Patent Office rejection stating that there was a new and nonobvious functional relationship between the information and the substrate.

Just as in *In re Miller*, the first and second information has a new and nonobvious functional relationship with the substrate, the cap. The first and second information is used to educate an observer, such as by identifying an event and the participants in the event. None of the cited references discloses such a functional relationship and therefore the information, as well as the recited location of the information, which must be given patentable weight, distinguish over the cited art.

Furthermore, *In re Gulak* continued the holding in *In re Miller* and concerned an educational and mathematical device wherein a series of numbers were placed on a circular band that could be placed upon a hatband or other article of apparel. The information related to numbers, multiplication tables and other information to be displayed to an observer. The Federal Circuit found the invention patentable over the prior art because the information was functionally related to the band on which it was placed.

The present invention is similar to *Gulack* because, just as in *Gulack*, the first and second information is functionally related to the cap. The information may be used to educate an observer as to the specific event as well as the participants in the event. The information located on the cap educates an observer just as the information on the hatband in *Gulack* educates an observer, thereby both being functionally related to the respective substrates.

Claims 2-3, 5-9, and 11-18 depend cognately from claim 1 and recite further significant structural detail to further distinguish over the combination of Loeffelholz and Kronenberger. Furthermore, patentable weight must be given to the features recited therein as the information, as well as the location of the information, has a functional relationship with the cap, which cannot be ignored. For example, claim 2 recites that the

second information can be seen but is not identifiable when viewing the headwear piece from a front elevation perspective, whereas claim 3 recites that the second information cannot be seen from a front elevational perspective. As discussed *supra*, the location of the information must be given patentable weight. The location of the information, as well as the ability to view and identify the information resulting therefrom, must be given patentable weight.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Loeffelholz in view of Kronenberger and further in view of U.S. Patent No. 6,408,443 (Park). Park adds nothing regarding the above-noted shortcomings of Loeffelholz and Kronenberger. Therefore, as Loeffelholz, Kronenberger and Park, each taken alone or in combination, fail to disclose or suggest the features recited in independent claim 1, the rejection of dependent claim 10 is improper and should be withdrawn.

Claims 19-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Loeffelholz in view of Kronenberger and further in view of U.S. Patent No. 5,584,076 (Armstrong). Claims 19-21 are directed to an adjustable strap, and in the case of claims 20 and 21, information thereon. Claims 21 specifically characterizes the information as identifying the event, as does the first information recited in claim 1.

While Armstrong discloses information on an adjustable strap, the information is not described as being correlated with any corresponding first and second information, as with an event, as claimed. Additionally, Armstrong adds nothing regarding the above-noted shortcomings of Loeffelholz and Kronenberger. Therefore, as Loeffelholz, Kronenberger and Park, each taken alone or in combination, fails to disclose or suggest the features

recited in independent claim 1, the rejection of dependent claims 19-21 is improper and should be withdrawn.

Reconsideration of the rejection of claims 2,3 and 5-21, clarification of the status of claim 1, and allowance of the case are requested.

Respectfully submitted,

By


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